

REMARKS

As correctly noted in the Office Action Summary, Claims 1-15 are pending.

Applicants respectfully request consideration and acknowledgment of the IDS submitted October 30, 2001. Further, Applicants request acknowledgment of Applicants' claim for convention priority submitted October 30, 2001.

Applicants have amended claims 2, 3, 7 and 11 to correct certain spelling errors. Applicants believe that no prohibited new matter has been introduced by entry of these amendments. Further, Applicants submit that no subject matter was canceled by this amendment.

1. Restriction Requirement

Applicants hereby provisionally elect **with traverse** the claims of **Group I** (Claims 1-10), which are drawn to a nucleic acid or host cell comprising the vector). The Examiner has also required the election of a single species (transcription factors), to which the claims will be restricted if no generic claim is held to be allowable. Applicants hereby provisionally elect **with traverse**, the species, **AP-1**. This election is for search purposes only.

Applicants traverse the election of Group I for at least the following reasons. Under M.P.E.P. § 803, a restriction is proper if the subject matter can be restricted into one of two or more claimed inventions, and these inventions are either independent (M.P.E.P. § 806.04) or distinct (M.P.E.P. § 806.05). However, the second element for a restriction requirement to be proper is that *if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits*, even though it includes claims to independent and distinct inventions. This point was recently emphasized by the Directors of Group 1600 at the October 29, 2003 Biotechnology/Chemical/Pharmaceutical Customer Partnership Meeting.

Applicants submit that a burden to examine both groups of claims has not been set forth. Moreover, Applicants assert that a search of the subject matter of Group I would be

coextensive of a search of the claimed Group II subject matter (*i.e.*, Claims 11-13 drawn to pharmaceutical compositions comprising compounds of regulating the expression of the MCP-1 gene). Additionally, the claims of Group II are linked to the claims of Group I (*i.e.*, they depend from the claims of Group II). The Office may make and maintain a restriction requirement between the properly divisible inventions if the linking claims are not patentably distinguishable over the art. Thus, if the linking claim is found allowable, the restriction requirement must be withdrawn with respect to any claims that fall within the scope of the linking claim. *See* M.P.E.P. § 809.

Additionally, the added species requirement further limits any search burden (which has not been demonstrated to exist). Therefore, in view of at least the species election, all the claims (*i.e.*, claims 1-15) should be rejoined because of the reduced search by the election AP-1.

Applicants further note that the claims of Group III (*i.e.*, Claims 14-15 which are drawn to a method for treating atherosclerosis or cancer using a nucleic acid sequence of Group I) falls within the same class as the claims of Group II. Additionally, like with the Claims of Group II, the claims of Group III share a common linking claim indirectly through the claims of Group II. The same arguments as stated for Group II thus apply for the claims of Group III at least with respect to linking claims. Moreover, a search of these claims would also be coextensive, and thus poses no additional burden.

Based on the above arguments, a *prima facie* showing of why the restriction is necessary has not been adduced. Accordingly, Applicants respectfully request reconsideration of the restriction, withdrawal of the election, and rejoinder of the claims.

CONCLUSION

Accordingly, for at least all of the reasons set forth above, withdrawal of the requirement for restriction is requested and believed to be in order. Further and favorable consideration of all the claims of record on the merits is respectfully requested.

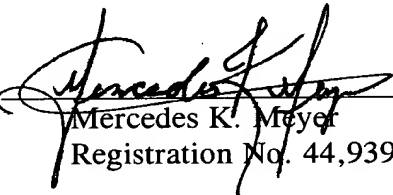
In the event that there are any question relating to this Reply to Restriction Requirement, or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: December 23, 2003

By:


Mercedes K. Meyer
Registration No. 44,939

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620